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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,650

05/12/2005

Darren Mckerrecher

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6547

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08/08/2006

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EXAMINER

MORRIS, PATRICIA L

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/534,650	Applicant(s) MCKERRECHER ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, the instance wherein A is a pyridine and R³, R⁵ and R⁶ represent nonheterocyclic groups.

Group II, the instance wherein A is a pyridine, R³ is an isoxazole and R⁵, R⁶ represent nonheterocyclic groups.

Group III, the instances wherein X is a pyridine, R³ is a thiophene and R⁵, R⁶ represent nonheterocyclic groups.

Group IV, the instance wherein A is a thiazole and R³, R⁵ and R⁶ represent non-heterocyclic groups.

Group V, any compound not set forth in Groups I-IV because claim 1 is too vague to further group.

Group VI, claim 8, drawn to multiple uses.

Group VII, claim 9, drawn to multiple processes.

Group X, claim 10, drawn to an intermediate.

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The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-V and VII are related as products and processes of preparing. In the instant case, the products as claimed can be made by materially different processes as evidenced by applicants' own claims and specification.

Groups I-V and X are related as final products and as intermediates. In the instant case, the intermediates have other uses such as sedatives, corrosion inhibitors, antifogging agents, etc.

Due to the numerous variables R^3 , R^5 , R^6 , etc., and their widely divergent meanings, and the numerous processes of preparing, a precise listing of inventive groups cannot be made.

Illustrative of different inventive concepts may be made by reference to the compounds in the Examples of the instant application, as for example:

the compounds of

I. Example 2.

II. Example 3

III. Example 6 etc,

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a benzofuran group, which does not define a contribution over the prior art. The substituents on the structure vary extensively and when taken as a whole result in vastly different compounds. The claims encompass all heterocyclic chemistry. Accordingly, unity of invention is considered

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to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

In the event of any election of either Groups V or VIII, applicants are required to elect a single compound.

Claims 1-7 will be examined to the extent readable on the elected compounds.

37 CFR 1.475(b) an international or a national stage application containing claims drawn to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories:

- (1) A product and a process specifically adapted for the manufacture of said product;
or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product,
and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the
said process; or
- (5) A product, a process specifically adapted for the manufacture of the said product,
and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combination of categories of inventions set forth in paragraph (b) of this section, unity of invention might not be present.

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(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories relied thereto will be considered as the main invention in the claims.

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claim or as alternatives within a single claim.

Once applicant has elected a compound from Groups I, II, III, IV or V, he is permitted to have, in view of the fact that this application enters the national stage through 35 U.S.C. 371, no more than one process of preparing that elected product and one method of use. See PCT Rule 13.2.

Also, note 1134 OG 197, where it is specifically recited that under PCT Rule 13.2(i), claims are permitted to one product and one process of preparing.

In the event of an election of either Groups I - V, applicants, applicants are requested to elect one single process of preparing and one method of use, *i.e.*, a specific disease.

Because these inventions lack unity of invention for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper

Applicant may file the divisional subject matter noted in divisional applications. If applicant wishes a generic expression of the elected invention the claims here need be amended to reflect that election.

This restriction requirement is being written as previous experience has indicated that with Foreign applicants and the inherent time delays, applicants' representative is better able to make

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an informed, correct, election of the invention applicants would wish to have prosecuted here if applicants are given the opportunity to see the restriction requirement laid out, and given the time to make an informed decision.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

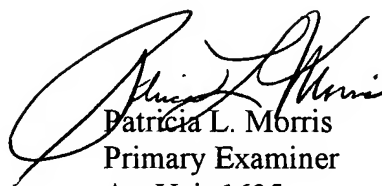
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
August 3, 2006